

REMARKS

Applicants thank the Examiner for indicating that claims 19-22 are directed to allowable subject matter. Applicants have rewritten claim 19 to incorporate the limitations of claim 1 and have added new claims 26-29, depending from claim 19 and corresponding to claims 2-5, respectively. Claims 19-22 and 26-29 are now allowable.

Applicants have also amended claim 18 to overcome the rejection under 35 USC 112, second paragraph. From base claim 1 it is apparent that the outlet is formed on the conduit. The rejection of claim 18 should be withdrawn.

Claims 1-11, 13-18, 24 and 25 stand rejected under 35 USC 103(a) on Conrad in view of Usui. This rejection is respectfully traversed. Even if one assumes that Conrad provides the disclosure for which it is cited, which applicants do not concede, Usui cannot complete the Examiner's case of *prima facie* obviousness. Therefore, the rejection should be withdrawn.

The Examiner's first error is the statement that "Conrad . . . and Usui are analogous because both references are directed to interior piping structures." Not only does this statement beg the question, it is incorrect when the actual disclosures of Conrad and Usui are considered. Conrad discloses a vacuum cleaner. At column 1, lines 8-14, Usui describes his invention as relating to "a heat conduction pipe and a heat exchanger assembled with said heat conduction pipes for performing thermal exchange between cooling water, cooling air, cooling medium for air conditioner, or other cooling mediums and EGR gas (Exhaust Gas Recirculation) gas [sic] or combustion exhaust gas including soot in a multitube heat exchanger such as an EGR cooling mechanism and so on." The question the Examiner begs is, why, considering that applicants' invention and Conrad both relate to cyclonic separating apparatus for vacuum cleaners, would any person of ordinary skill in the art pertaining to the invention and Conrad have had any reason whatever to look at Usui to help in solving any known problems in the field of the invention or Conrad? The question answers itself – No such person would have had any reason whatever to look to Usui, except in highly imaginative hindsight. Without a reason to make the combination

proposed by the Examiner, the rejection cannot stand. Conrad and Usui are simply not related sufficiently to be combined as proposed.

Applicants also respectfully suggest that saying that Conrad and Usui “are directed to interior piping structures” is not enough to support the proposed combination. Usui states that what it discloses is intended to solve the problems of the prior art relating to the deposition of soot on heat conduction pipes. The conduits disclosed in Conrad are nothing at all like the pipes disclosed in Usui.

The Examiner’s second error is the assertion at the bottom of page 3 of the Action that it would have been obvious to use Usui’s teachings to form grooves in Conrad’s conduit “in order to reduce noise level, increase heat exchange transfer area, [provide] more flow area, and achieve low pressure drop.” Of course, Conrad’s apparatus and the claimed invention are not directed to any heat exchange function, so there would have been no reason to look to Usui to “increase heat exchange transfer area” in Conrad’s apparatus since its thermal properties and the thermal properties of the fluid flowing inside it are not a consideration and are irrelevant to applicant’s invention as claimed in this application. The remaining benefits allegedly taught by Usui are not taught by Usui but are instead brought about by the present invention – Usui says nothing whatever about reduction in noise level or achieving low pressure drop, which is understandable because Usui’s disclosure has nothing to do with such advantages.

Since there would have been no reason for a person of ordinary skill in the art to have made the Examiner’s proposed combination of Usui and Conrad, the rejection should be withdrawn.

The rejection of claim 19 under 35 USC 103(a) on Conrad and Usui in view of Demarest should also be withdrawn because Conrad and Usui do not provide the teachings for which they are cited.

Early action allowing claims 1-22 and 24-29 is solicited.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 424662012800.

Respectfully submitted,

Dated: December 3, 2008

By:



Barry E. Bretschneider
Registration No. 28,055

Morrison & Foerster LLP
1650 Tysons Boulevard, Suite 400
McLean, Virginia 22102
Telephone: (703) 760-7743
Facsimile: (703) 760-7777